

### **REMARKS/ARGUMENTS**

Claims 1-120 are pending in the present application.

This Amendment is in response to the Office Action mailed December 24, 2009. In the Office Action, the Examiner rejected claims 1-5, 7, 11-15, 17, 21-32, 38, 40-42, 44-46, 48, 49, 51, 53, 54, 57, 60-65, 67, 71-75, 77, 81-85, 87, 91-95, 97, 101-105, 107, and 111-115 under 35 U.S.C. §102(b); and 6, 8-10, 16, 18-20, 39, 43, 47, 50, 52, 55, 56, 58, 66, 68-70, 76, 78-80, 86, 88-90, 96, 98-100, 106, 108, 110, 116, and 118-120 under 35 U.S.C. §103(a). In addition, the Examiner indicates allowable subject matter for claims 33-37. Claims 1, 11, 61, 71, 81, 91, 101 and 111 have been amended. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Rejection Under 35 U.S.C. § 102***

In the Office Action, the Examiner rejected claims 1-5, 7, 11-15, 17, 21-32, 38, 40-42, 44-46, 48, 49, 51, 53, 54, 57, 60-65, 67, 71-75, 77, 81-85, 87, 91-95, 97, 101-105, 107, and 111-115 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,684,859 issued to Chanroo et al. ("Chanroo"). Applicant respectfully traverses the rejection and submits that the Examiner has not met the burden of establishing a prima facie case of anticipation.

Chanroo discloses a method and apparatus for downloading location specific information to selective call receivers. A selective call system 100 comprises a paging (or terminal) controller 104 coupled to a telephone network 102 and a plurality of base sites 120-124, each having an associated geographic areas (or coverage areas) 105-106. The paging controller 104 accesses a subscriber database 130 coupled thereto to obtain subscriber information 138 comprising a subscriber address, a location identifier 132 and location specific information 134 (Chanroo, col. 2, lines 40-47). The general location specific information include, for example, telephone numbers of the local telephone directory, such as hotels, restaurants, theaters, taxis, and other general information relating to a particular city (geographic area or service area) (Chanroo, col. 2, lines 58-62). A selective call receiver 108 comprises an antenna 302 for intercepting transmitted radio frequency (RF) signals which are coupled to the input of a receiver 304. The RF signals are preferably selective call (paging) message signals which provide, for example, a receiver address, location identifier 132 and an associated message, such as voice message

(Chanroo, col. 5, lines 30-36). The receipt of the message by the selective call receiver 108 can automatically generate the ack-back response to the selective call base station to inform it that the message was successfully received (Chanroo, col. 6, lines 7-10). Preferably, the decoder/controller 306 decodes when a new location identifier 132 is received (Chanroo, col. 6, lines 10-12). The ack-back signal is forward to the home service area encoded with the new location identifier 132 (Chanroo, col. 6, lines 15-17). When the user is within range of a cordless telephone call point station 702, the message processor 820 signals the telephone control logic (controller) 830 to call up the home paging controller 714 to transfer the new location identifier of the pager/cordless telephone transceiver 720 (Chanroo, col. 14, lines 5-10).

Chanroo does not disclose, either expressly or inherently, at least one of:

(A1) a decoder to decode an activation message containing a predefined frequency, code, or bit pattern, the activation message being sent from a request subsystem via a communication medium in response to a telephony call, the decoder generating an activation command upon detecting the predefined frequency, code, or bit pattern; and (A2) a transmitting unit coupled to the decoder to transmit a signal modulated from an information message to a receiver using a communication protocol, in response to the activation command, the information message containing a geographical location of a transmitter containing the transmitting unit; as recited in claims 1, 61, 81, and 101;

(B1) a decoder to decode an activation message, the activation message being sent from an activator in response to a telephony call, the decoder generating an activation command; and (B2) a receiving unit coupled to the decoder to receive a signal containing an information message upon enabled by the activation command, the information message being sent from a transmitter according to a communication protocol via a communication medium and containing a geographical location of the transmitter; as recited in claims 11, 71, 91, and 111;

(C1) a plurality of commonly coupled location transmitters, each transmitter comprising a transmission unit to broadcast a signal modulated from an information message containing respective geographical location information of the transmitter upon receipt of an activation request that requests the geographical location information, the activation request being generated from a request subsystem in response to a telephony call; as recited in claim 21;

(D1 receiving a location information request from a request subsystem in response to a telephone call, the location information request requiring a geographical location information; (D2) generating at least one data packet comprising the geographical location information; and (D3) transmitting the at least one data packet upon receipt to a network of an activation command in response to the location information request; as recited in claim 38;

(E1) a receiver to receive geographical location information associated with a transmitter, the geographical location information being transmitted by the transmitter in response to a telephony call; (E2) a processor coupled to the receiver to process the geographical location information and to enable the receiver to receive the geographical location information; and (E3) a network interface coupled to the processor to transmit the geographical location information over a network; as recited in claims 54, 57;

(F1) a location sensor to provide geographical location information embedded in an information message in response to a telephony call; (F2) a determination unit coupled to the sensor, the determination unit to determine the geographical location information from the information message; and (F3) a network interface coupled to the determination unit to selectively transmit the geographical location information over a network; as recited in claims 60.

Chanroo merely discloses the decoder/controller 306 decodes when a new location identifier 132 is received (Chanroo, col. 6, lines 10-12), not decode an activation message. The decoder/controller 306 merely compares a received address with one or more addresses stored in a codeplug memory 322 and when a match is detected, an alert signal is generated to alert a user that a selective call message, or page, has been received (Chanroo, col. 5, lines 54-59).

In addition, the received address is not an activation message that contains a predefined frequency, code, or bit pattern. Since the received address may be any address, it cannot be a predefined code.

Furthermore, the decoder/controller 306 transmits the ack-back signal only when there is a match between the received address and the stored addresses (Chanroo, col. 5, lines 57-58). Matching with stored addresses is not the same as detecting if the message contains the predefined frequency, code, or bit pattern. To clarify this aspect of the invention, claims 1, 11, 61, 71, 81, 91, 101 and 111 have been amended.

Moreover, Chanroo merely discloses the general location specific information include, for example, telephone numbers of the local telephone directory, such as hotels, restaurants, theaters, taxis, and other general information relating to a particular city (geographic area or service area) (Chanroo, col. 2, lines 58-62), not a geographical location of a transmitter containing the transmitting unit. The location information is only about the new service area, it is not related to the specific location of the transmitter.

To anticipate a claim, the reference must teach every element of a claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989). The Examiner bears the burden of presenting at least a prima facie case of anticipation. *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138-139 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Only if that burden is met, does the burden of going forward shift to the applicant. *In re King*, 801 F.2d at 1327, 231 USPQ at 138-139; *In re Wilder*, 429 F.2d at 450, 166 USPQ at 548. Once a prima facie case is established and rebuttal evidence is submitted, the ultimate question becomes whether, based on the totality of the record, the Examiner carried his burden of proof by a preponderance. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If the Examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Since the Examiner failed to show that Chanroo teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

Therefore, Applicant believes that independent claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, and 111 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §102(b) be withdrawn.

***Rejection Under 35 U.S.C. § 103***

In the Office Action, the Examiner rejected: (1) Claims 6, 16, 66, 76, 86, 96, 106, and 116 under 35 U.S.C. §103(a) as being unpatentable over Chanroo in view of U.S. Patent No. 6,084,862 issued to Bjork et al. ("Bjork"); (2) Claims 8, 9, 18-20, 43, 47, 55, 58, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120 under 35 U.S.C. §103(a) as being unpatentable over Chanroo in view of U.S. Patent No. 6,603,977 issued to Walsh et al. ("Walsh"); (3) Claims 10, 20, 50, 52, 56, 59, 70, 80, 90, 100, 110, and 120 under 35 U.S.C. §103(a) as being unpatentable over Chanroo in view of U.S. Patent No. 6,169,895 issued to Buhrmann et al. ("Buhrmann"); (4) Claim 39 under 35 U.S.C. §103(a) as being Official Notice.

Applicant respectfully traverses the rejections and submits that the Examiner has not met the burden of establishing a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP §2143, p. 2100-129 (8th Ed., Rev. 2, May 2004)*. Applicants respectfully submit that there is no suggestion or motivation to combine their teachings, and thus no *prima facie* case of obviousness has been established.

Furthermore, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated: "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined." *MPEP 2141*. In *KSR International Co. vs. Teleflex, Inc.*, 127 S.Ct. 1727 (2007) (Kennedy, J.), the Court explained that "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." The Court further required that an explicit analysis for this reason must be made.

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR 127 S.Ct.* at 1741, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). In the instant case, Applicant respectfully submits that there are significant differences between the cited references and the claimed invention and there is no apparent reason to combine the known elements in the manner as claimed, and thus no *prima facie* case of obviousness has been established.

1. Claims 6, 16, 66, 76, 86, 96, 106, and 116:

Chanroo is discussed above.

Bjork discloses a time dispersion measurement in radio communications systems. A radio channel 203 is modeled to include a Finite Impulse Response (FIR) filter 401, the output of which is added to a white noise signal. The purpose of the white noise is to ensure that the model models all of the interference in the radio channel (Bjork, col. 7, lines 15-21).

Chanroo and Bjork, taken alone or in any combination, do not disclose, suggest, or render obvious, at least one of: (A), (B), (C), (D), (E), and (F) above; and (1) a decoder to decode an activation message, the activation message being sent from a request subsystem via a communication medium in response to a telephony call, the decoder generating an activation command; (2) a transmitting unit coupled to the decoder to transmit a signal modulated from an information message to a receiver using a communication protocol, in response to the activation command; (3) the transmitting unit comprises a modulator to modulate the information message according to a modulating scheme; (4) the modulating scheme is compatible with a sound signal; and (5) the modulating scheme uses a pseudo random binary sound (PRBS).

As discussed above, Chanroo does not disclose or suggest elements (A), (B), (C), (D), (E), and (F) above. Therefore, a combination of Chanroo with any other references in rejecting claims 6, 16, 66, 76, 86, 96, 106, and 116 is improper.

Furthermore, Bjork merely discloses modeling a radio channel (Bjork, col. 7, lines 15-21), not modulating. Modeling is used to calculate the most probable transmitted data as part of a receiver. In contrast, modulating is used to transmit data, which is the opposite of receiving data. Moreover, Bjork merely discloses using the white noise to model all the interference in the radio channel (Bjork, col. 7, lines 15-21), not the information message. Interference includes co-

channel interference, adjacent interference, thermal noise, and any other interference. In contrast, information message contains the information, which is the opposite of the interference.

2. Claims 8, 9, 18-20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120:

Chanroo is discussed above.

Walsh discloses a location information system for a wireless communication device and method therefor. The location information represents locations of predetermined areas, such as floors, rooms, hallway, etc. (Walsh, col. 8, lines 38-40). In an E911 application, the wireless communication unit sends the location information at least one of before, during, and after the wireless communication device communicates an emergency telephone call to a public safety answering point (Walsh, col. 11, lines 42-46).

Chanroo and Walsh, taken alone or in any combination, do not disclose, suggest, or render obvious, at least one of: (A), (B), (C), (D), (E), and (F) above; and (1) a decoder to decode an activation message, the activation message being sent from a request subsystem via a communication medium in response to a telephony call, the decoder generating an activation command; (2) a transmitting unit coupled to the decoder to transmit a signal modulated from an information message to a receiver using a communication protocol, in response to the activation command; (3) the information message includes a location identifier corresponding to location of the transmitting unit; (4) the location identifier includes global positioning system (GPS) information, as recited in claims 8, 18, 68, 78, 88, 98, 108, and 118; and (5) the telephony call is made by a person located in proximity of the transmitter, as recite in claims 9, 19, 69, 79, 89, 99, 109, and 119; and (6) the telephony call is an emergency call using an emergency call number, as recited in claims 20, 70, 80, 90, 100, 110, and 120.

As discussed above, Chanroo does not disclose or suggest elements (A), (B), (C), (D), (E), and (F) above. Therefore, a combination of Chanroo and any other references in rejecting claims 8, 9, 18-20, 68-70, 78-80, 88-90, 98-100, 108-110, and 118-120 is improper.

Moreover, Walsh merely discloses the location information associated with a plurality of predetermined areas in the facility such as a floor, a room, etc. (Walsh, col. 10, lines 42-44, lines 54-59), not the location information of the transmitters. Walsh does not disclose or suggest the telephone call made by a person located in proximity of the location of the transmitting unit. Walsh merely discloses location descriptions associated with a plurality of predetermined areas

210-213 (Walsh, col. 8, lines 18-21). Since these are predetermined areas, they cannot be associated with a person making a telephone call who may be located outside these areas.

3. Claims 10, 20, 50, 52, 56, 59, 70, 80, 90, 100, 110, and 120:

Chanroo is discussed above.

Buhrmann discloses a landline-supported private base station for collecting data and switchable into a cellular network. When an incoming call is directed to a particular mobile station, the private base station detects the ring and sends an alerting signal to the registered mobile station (Buhrmann, col. 6, lines 19-21, 28-30). A memory unit 102 can store emergency number (Buhrmann, col. 8, lines 9-10). Upon depression of an emergency button, the stored emergency number is dialed and sent to a cellular network (Buhrmann, col. 8, lines 36-40).

Chanroo and Buhrmann, taken alone or in any combination, do not disclose, suggest, or render obvious, at least one of: (A), (B), (C), (D), (E), and (F) above; and the telephony call is an emergency call using an emergency call number.

As discussed above, Chanroo does not disclose or suggest elements (A), (B), (C), (D), (E), and (F) above. Therefore, a combination of Chanroo and any other references in rejecting claims 10, 20, 50, 52, 56, 59, 70, 80, 90, 100, 110, and 120 is improper.

Moreover, Buhrmann merely discloses the memory unit 102 can store emergency number (Buhrmann, col. 8, lines 9-10) or upon depression of an emergency button, the stored emergency number is dialed and sent to a cellular network (Buhrmann, col. 8, lines 36-40), not the telephony call is an emergency call using an emergency call number to which an activation message is sent. The emergency number is merely dialed and sent to a cellular network. Buhrmann does not disclose that in response to this emergency call, an activation message is sent.

4. Claim 39:

Chanroo is discussed above.

The Examiner merely takes Official Notice that the feature as recited is very well known in the art without specifically providing an analysis how it is obvious to combine with the cited prior art.

Applicants submit that such an official notice is inappropriate.

Official notice unsupported by documenting evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art are



capable of instant and unquestionable demonstration as being well known. *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970); MPEP 2144.03A. It would not be appropriate for the Examiner to take official notice of facts without citing a prior art references. MPEP 2144.03A. Furthermore, if official notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable. MPEP 2144.03B.

Here, Charon does not disclose or suggests the use of data packet complies with Internet Protocol. The Examiner did not provide a technical line of reasoning which must be clear and unmistakable. The Examiner merely states that “the feature as recited is very well known in the art,” without explaining how Charon can be modified to incorporate the Internet Protocol. Since Charon does not disclose a packet, Charon cannot disclose the packet complies with the Internet Protocol.

The Examiner failed to establish a prima facie case of obviousness. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). “When determining the patentability of a claimed invention which combined two known elements, ‘the question is whether there is something in the prior art as a whole suggest the desirability, and thus the obviousness, of making the combination.’” *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992), 24 USPQ2d 1040; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ (BNA) 481, 488 (Fed. Cir. 1984). To defeat patentability based on obviousness, the suggestion to make the new product having the claimed characteristics must come from the prior art, not from the hindsight knowledge of the invention. *Interconnect Planning Corp. v. Feil*, 744 F.2d 1132, 1143, 227 USPQ (BNA) 543, 551 (Fed. Cir. 1985). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. In other words, the Examiner must

show reasons that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the prior elements from the cited prior references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1996), 47 USPQ 2d (BNA) 1453. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973. (Bd.Pat.App.&Inter. 1985). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 USPQ2d at 1432; *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992), 23 USPQ2d 1780.

Moreover, the Examiner failed to establish the factual inquires in the three-pronged test as required by the *Graham* factual inquires. There are significant differences between the cited references and the claimed invention as discussed above. Furthermore, the Examiner has not made an explicit analysis on the apparent reason to combine the known elements in the fashion in the claimed invention. Accordingly, there is no apparent reason to combine the teachings of any combination of Charon, Bjork, Walsh and Buhrmann, and official notice.

In the present invention, the cited references do not expressly or implicitly suggest any of the above elements. In addition, the Examiner failed to present a convincing line of reasoning as to why a combination of Charon, Bjork, Walsh and Buhrmann, and official notice is an obvious application of automatic remote communication using network telephony.

Therefore, Applicant believes that independent claims 1, 11, 21, 38, 54, 57, 60, 61, 71, 81, 91, 101, and 111 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicant respectfully requests the rejections under 35 U.S.C. §103(a) be withdrawn.

***Conclusion***

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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